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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,474	06/26/2003	Robert P. Cozier	100110604-1	5651

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EXAMINER
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BONSHOCK, DENNIS G

ART UNIT	PAPER NUMBER
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2173

MAIL DATE	DELIVERY MODE
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05/29/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/606,474

Applicant(s)

COZIER ET AL.

Examiner

Dennis G. Bonshock

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 and 19 March 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **FINAL REJECTION**

### ***Response to Amendment***

1. It is hereby acknowledged that the following papers have been received and placed on record in the file: Amendment as received on 3-19-2007.

2. Claims 1-11 have been examined.

#### **Status of Claims:**

3. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugimoto, Patent No.: US 6,829,009 B2 and Ward et al., Patent No.: US 6,784,924, B2, hereinafter Ward.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugimoto, Patent No.: US 6,829,009 B2 and Ward et al., Patent No.: US 6,784,924, B2, hereinafter Ward.

6. With regard to claim 1, which teaches a system comprising: a display; an external device coupled to the system; and customizable menu that is displayable on the display and which comprises a plurality of customizable and selectable user interface items that respectively correspond to selected tasks or actions that may be

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performed by a user, each user interface item having one or more subtasks or sub-actions associated therewith, which tasks/actions and subtasks/sub-actions are selectable by the user and which initiates a through connection with the external device, and causes the selected task or action to be performed on the external device in a preprogrammed manner, Sugimoto teaches, in column 3, lines 30-35 and 44-50, a digital camera comprising a display for allowing user selection of options from a menu. Sugimoto further teaches, in column 7, lines 10-20, the automatic customization of the menu. Sugimoto further teaches, in column 6, lines 6-25 and figure 5, user selectable menu options where menu options have sub-menu options further selectable by the user.

Sugimoto teaches, in column 3, lines 15-19, a digital Input/Output interface terminal and video output terminal, Sugimoto further teaches, in column 3, lines 51-57, a read-out mode and a PC mode, all of which imply that the system is capable of outputting data to an external device for further processing, however, doesn't list menu options initiating a connection with an external device. Ward teaches a digital camera with a LCD for selecting menu options from a custom subset of a menu (see column 3, lines 15-26), similar to that of Sugimoto, but further teaches the camera being in communication with a external device and selecting a menu option to initiate a connection with the external device, for performing a selected action (see column 1, lines 57-62 and column 3, lines 14-39). Ward teaches, in column 5, lines 8-11, column 2, lines 54-58, and in column 1, lines 57-62, selection of an LCD Icon causing a image/other data to be transmitted over the network to an ISP/PC for saving/printing, in

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a manner not programmed presently (previously programmed). This previously programmed transfer can further be seen in column 2, lines 59-65, which teaches an initial set up for the camera via an application located remotely that enables the user to specify the name of the destination ISP or online service and to input appropriate communication settings and account information. It would have been obvious to one of ordinary skill in the art, having the teachings of Sugimoto and Ward before him at the time the invention was made to modify camera of Sugimoto to include the means for establishing a connection to an external device, as did Ward. One would have been motivated to make such a combination because cameras have a limited storage space and through connection to an external device (printer, PC, etc.) the user is able to transfer images off of the camera and increase storage capacity, furthermore, initiating the transfer from the camera allows the user to easily transmit images to a desired location.

7. With regard to claim 2, which teaches the system comprises a digital camera, Sugimoto teaches, in column 3, lines 6-35, the system comprising a digital camera.

8. With regard to claim 3, which teaches the tasks are selected from the group consisting of printing, e-mailing, archiving and downloading data from the system, Ward teaches, in column 1, lines 57-62 and column 3, lines 14-39, using the system for transmitting images to a storage location, printing, or emailing the images.

9. With regard to claim 4, which teaches the external device comprises a printer, Ward teaches, in column 3, lines 14-39 and column 5, lines 8-11, connecting the camera to a print device.

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10. With regard to claim 5, which teaches the external device comprises a computer, Ward teaches, in column 1, lines 25-33, column 3, lines 14-39, and column 5, lines 8-11, the external device being a personal computer.

11. With regard to claim 6, which teaches a method comprising the steps of: providing a system comprising a display and an external device coupled to the system; programming the system to have a customizable menu that is displayable on the display and which comprises a plurality of customizable and selectable user interface items that respectively correspond to selected tasks or actions that may be performed by a user, each icon selectively having one or more subtasks or sub-actions associated therewith; selecting one of the icons to perform a desired task or action; and initiating a through connection with the external device to cause the selected task or action to be performed on the external device in a preprogrammed manner, Sugimoto teaches, in column 3, lines 30-35 and 44-50, a digital camera comprising a display for allowing user selection of options from a menu. Sugimoto further teaches, in column 7, lines 10-20, the automatic customization of the menu. Sugimoto further teaches, in column 6, lines 6-25 and figure 5, user selectable menu options where menu options have sub-menu options further selectable by the user.

Sugimoto teaches, in column 3, lines 15-19, a digital Input/Output interface terminal and video output terminal, Sugimoto further teaches, in column 3, lines 51-57, a read-out mode and a PC mode, all of which imply that the system is capable of outputting data to an external device for further processing, however, doesn't list menu options initiating a connection with an external device. Ward teaches a digital camera

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with a LCD for selecting menu options from a custom subset of a menu (see column 3, lines 15-26), similar to that of Sugimoto, but further teaches the camera being in communication with a external device and selecting a menu option to initiate a connection with the external device, for performing a selected action (see column 1, lines 57-62 and column 3, lines 14-39). Ward teaches, in column 5, lines 8-11, column 2, lines 54-58, and in column 1, lines 57-62, selection of an LCD Icon causing a image/other data to be transmitted over the network to an ISP/PC for saving/printing, in a manner not programmed presently (previously programmed). This previously programmed transfer can further be seen in column 2, lines 59-65, which teaches an initial set up for the camera via an application located remotely that enables the user to specify the name of the destination ISP or online service and to input appropriate communication settings and account information. It would have been obvious to one of ordinary skill in the art, having the teachings of Sugimoto and Ward before him at the time the invention was made to modify camera of Sugimoto to include the means for establishing a connection to an external device, as did Ward. One would have been motivated to make such a combination because cameras have a limited storage space and through connection to an external device (printer, PC, etc.) the user is able to transfer images off of the camera and increase storage capacity, furthermore, initiating the transfer from the camera allows the user to easily transmit images to a desired location.

12. With regard to claim 7, which teaches further comprising the step of: after selecting one of the icons to perform a desired task or action, selecting a subtask or

sub-action associated with the desired task or action, Sugimoto teaches, in column 6, lines 6-26 and in figure 5, selection of a menu icon revealing a plurality of sub-actions selectable by a user.

13. With regard to claim 8, which teaches the system comprises a digital camera, Sugimoto teaches, in column 3, lines 6-35, the system comprising a digital camera.

14. With regard to claim 9, which teaches wherein the tasks are selected from the group consisting of printing, e-mailing, archiving and downloading data from the system, Ward teaches, in column 1, lines 57-62 and column 3, lines 14-39, using the system for transmitting images to a storage location, printing, or emailing the images.

15. With regard to claim 10, which teaches wherein the external device comprises a printer, Ward teaches, in column 3, lines 14-39 and column 5, lines 8-11, connecting the camera to a print device.

16. With regard to claim 11, which teaches wherein the external device comprises a computer, Ward teaches, in column 1, lines 25-33, column 3, lines 14-39, and column 5, lines 8-11, the external device being a personal computer.

### ***Response to Arguments***

17. The arguments filed on 3-19-2007 have been fully considered but they are not persuasive. Reasons set forth below.

18. The applicants' argue that the Sugimoto patent does not disclose or suggest anything regarding connecting the camera to an external device.



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19. In response, the examiner respectfully submits that Sugimoto teaches, in column 3, lines 15-19, a digital Input/Output interface terminal and video output terminal, Sugimoto further teaches, in column 3, lines 51-57, a read-out mode and a PC mode, all of which imply that the system is capable of outputting data to PC for further processing.

20. The applicants' argue that Ward does not disclose or suggest that the camera is connected to an external device and performs a selected action on the external device.

21. In response, the examiner respectfully submits that Ward teaches, in column 5, lines 8-11, commands sent to the receiving entity to print select images or to save data to a particular file on a PC. Ward further teaches, in column 2, lines 38-59, a camera connected to a PC and a service provider via a network connection [40].

22. The applicants' argue that the references do not teach causing "a selected task or action to be performed on an external device in a preprogrammed manner".

23. In response, the examiner respectfully submits that Ward teaches, in column 5, lines 8-11, column 2, lines 54-58, and in column 1, lines 57-62, selection of an LCD Icon causing a image/other data to be transmitted over the network to an ISP/PC for saving/printing, in a manner not programmed presently (previously programmed). This previously programmed transfer can further be seen in column 2, lines 59-65, which teaches an initial set up for the camera via an application located remotely that enables the user to specify the name of the destination ISP or online service and to input appropriate communication settings and account information.

24. The applicants' argue that the transfers for Ward do not cause an action to occur on the printing machine.

25. In response, the examiner respectfully submits that Ward teaches, in column 5, lines 8-11, commands transmitted to the receiver/destination causing the receiver/destination to print one of the images or save a particular file on a PC.

26. The applicants' argue that the Examiner used improper hindsight reconstruction in formulating the rejection.

27. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Conclusion***

28. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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29. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis G. Bonshock whose telephone number is (571) 272-4047. The examiner can normally be reached on Monday - Friday, 6:30 a.m. - 4:00 p.m.

31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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32. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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